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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/766,220      | 01/28/2004  | Jethro Liou          | 46858.00023         | 2893             |

7590 07/25/2005

Squire, Sanders & Dempsey L.L.P.  
14th Floor  
801 S. Figueroa Street  
Los Angeles, CA 90017-5554

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| EXAMINER |
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PASSANITI, SEBASTIANO

|          |              |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

3711

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*Fale*

|                              |   |                                     |  |
|------------------------------|---|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/766,220    | <b>Applicant(s)</b><br>LIOU, JETHRO |  |
|                              | <b>Examiner</b><br>Sebastiano Passaniti | <b>Art Unit</b><br>3711             |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Office action is responsive to communication received 05/10/2005 –  
Amendment and Request for Extension of Time.

Claims 1-16 remain pending.

Following is an action on the MERITS:

#### ***Claim Rejections - 35 USC § 102 and 103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 5 and 6 STAND rejected under 35 U.S.C. 102(b) as being anticipated by Lo, as set forth in the last Office action, mailed 01/12/2005.

Claim 2 STANDS rejected under 35 U.S.C. 103(a) as being unpatentable over Lo in view of Liang and Wood, as set forth in the last Office action, mailed 01/12/2005.

Claims 4, 7 and 9-11 STAND rejected under 35 U.S.C. 103(a) as being unpatentable over Lo in view of Su, as set forth in the last Office action, mailed 01/12/2005.

Claim 8 STANDS rejected under 35 U.S.C. 103(a) as being unpatentable over Lo in view of Su, Ling and Wood, as set forth in the last Office action, mailed 01/12/2005.

Claims 12, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakahara (2003/0125127). Reference is made to Figure 2( C ) showing an opening in the top plate and an opening in the sole. The sole curves upwardly and is therefore considered to include an upward extending portion. See also paragraphs 31 through 35, wherein Nakahara details the specific materials for the composite covers, as required by claim 15, and the material for the main metal body, as required by claim 16.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakahara (2003/0125127) in view of Su. As to claim 13, Nakahara is silent regarding the specific method of attaching the composite crown to the metal main body. Su shows it to be old in the art to fabricate a hollow metallic club head from multiple pieces that are later joined using any one of a number of convenient and well-known processes such as welding, epoxying or screwing (col. 5, lines 39-48). In essence, Su teaches that it is old to combine both metallic and composite materials within the construction of the shell of a golf club head. In view of the patent to Su, it would have been obvious to modify the device in the cited art reference to Nakahara by bonding the composite cover to the top portion of the head and/or the sole, while separately forming the remaining sole, face, top and hosel pieces, said pieces later to be joined by welding,

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the motivation being to simply make use of conventional methods in the art for fixedly securing diverse elements of the club head assembly. Specific to claim 14, the use of two or more holes in the sole is deemed to be an obvious variation in the design of the head. Much in the same manner as Nakahara depicts a plethora of designs for the hole in the crown (Figures 3(a) through 3(t)), it is clear that a number of similar designs for the opening in the sole would have been obvious to the skilled artisan. In fact, Nakahara even hints that the configuration of the opening in the sole might very well be variable in shape (see paragraph 26 in Nakahara).

### ***Response to Arguments***

In the arguments received 05/10/2005, the applicant contends that the prior art reference to Lo does not show a composite cover to fit over at least a top plate portion of the head to cover an opening in the head. In addition, the applicant contends that the secondary teaching references do not render obvious the addition of a composite material to a club head so that the top plate is covered. Applicant makes specific arguments regarding the Liang and Wood references, noting that Liang shows a golf club head formed from a plurality of plates, while Wood shows a cover formed of multiple pieces.

In response to these arguments, it is important to note that while claims 1-6, particularly, may be styled in a typical "product-by-process" format, the method steps included within these claims do not further limit the structure of the club head.

Application of the prior art references in meeting the claim language is based upon the final claimed structure of the club head.

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Regarding the arguments presented with respect to the prior art reference to Lo, it is noted that ledges (34) may in fact be considered part of the top plate of the head. These ledges are indeed "covered" by the composite material of the top covers. The claim merely requires that the composite cover "cover" at least one opening in the top plate.

With respect to the arguments presented against the prior art patents to Wood and Liang, the fact that the applicant argues that the shell structure comprises multiple pieces subsequently joined together in each reference is irrelevant. Here, the Wood and Liang patents are referenced solely to show that the shell may include multiple openings in the upwardly extending sole portion. It does not matter that the outer shell of these prior art devices may include plural parts, as there is nothing in the claims that precludes the incorporation of multiple pieces.

#### ***Further references of interest***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See top cover (20) in Chen. Onoda shows a composite cover, of interest.

#### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.Passaniti/sp  
July 22, 2005

  
Sebastiano Passaniti  
Primary Examiner